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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,645

09/05/2006

Katsuya Okumura

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1797

22852

7590

03/04/2009

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EXAMINER

BENITEZ, JOSHUA

ART UNIT

PAPER NUMBER

2829

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,645	<b>Applicant(s)</b> OKUMURA ET AL.	
	<b>Examiner</b> JOSHUA BENITEZ	<b>Art Unit</b> 2829	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Amended claims 6-8 of U.S. Application No. 10/591,645 filed on 11/24/2008 are presented for examination. Claims 1-5 were previously cancelled. Claim 9 was previously withdrawn. Newly added claim 10 is also withdrawn as explained below.

### ***Election/Restrictions***

2. Newly submitted claim 10 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: it discloses subject matter similar to that of claim 9, which was previously withdrawn without traverse and its proper classification is also class 29, subclass 874.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin et al (U.S. Patent No. 7,112,974).

In re claim 6, Jin '974 discloses in figures 1-4 a probe (100) that comes into contact with an object to be inspected (410, 412) when inspecting an electrical characteristic of the object to be inspected (410, 412), the probe (100) comprising:

a probe main body (310) having a contact portion (120) that comes into contact with the object to be inspected (410, 412); and

conductive material each having a tip portion (121) projection from the contact portion (120) of said probe main body (310),

wherein the contact portion (120) has a contact surface that comes into contact with the object to be inspected (410, 412), the tip portion (121) formed to project from the contact surface, a projection length of the tip portion being larger than a thickness of an oxide film (412) formed on a surface of an electrode (410) of the object to be inspected, and the contact surface is formed substantially parallel to the surface of the electrode and comes into contact with the surface of the electrode (fig. 4) of the object to be inspected.

Jin '974 does not specifically disclose a plurality of conductive materials each having a tip portion projecting from the contact portion of said probe main body.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a plurality of conductive materials since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have provided a plurality of conductive materials, each having a

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tip portion projecting from the contact portion of said probe main body, as taught by the single probe of Jin et al, in order to provided multiple connections to test multiple sites at the same time reducing testing time.

As for the limitation of “to function as a stopper for the tip portions when the tip portions penetrate the oxide film to reach the electrode”, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

As for claims 7-8, Jin '974 discloses said conductive materials are buried in the contact portion and made of a material harder than the contact portion (col. 3, line 24 to col. 4, line 45), said material made of conductive diamond (131).

### ***Response to Arguments***

4. Applicant's arguments filed 11/03/2008 have been fully considered but they are not persuasive.

Regarding claim 6, Applicant argues in page 4, lines 20-23 the limitation of "substantially parallel to the surface of the electrode" is not suggested by Jin et al or the additionally cited prior art.

The Examiner respectfully disagrees. The new limitation does not differentiate the claimed invention from the cited art. "Substantially parallel" is a broad terminology that does not require the contact surface to be fully parallel to the surface of the

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electrode, but only requires being parallel to an extent. Figures 1-4 of Jin et al in fact teach the claimed limitation.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA BENITEZ whose telephone number is (571)270-1435. The examiner can normally be reached on M-Th, 7:30-5:00; F, 7:30-4:00 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. B./  
Examiner, Art Unit 2829  
February 27, 2009

/Ha T. Nguyen/

Supervisory Patent Examiner, Art Unit 2829